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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,560	02/03/2004	Christina Ligia Andrianov	HP/5-22833/A/CGC 2142	3735
324 7590 07/02/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			EXAMINER YOUNG, MICAH PAUL	
			ART UNIT 1618	PAPER NUMBER
			MAIL DATE 07/02/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/771,560	<b>Applicant(s)</b> ANDROANOV, CHRISTINA	
	<b>Examiner</b> Micah-Paul Young	<b>Art Unit</b> 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/6/04&amp;6/7/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

**Acknowledgment of Papers Received:** Information Disclosure Statements dated 5/06/04 and 6/07/04.

#### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-19 and 21 are rejected under 35 U.S.C. 102(a,e) as being anticipated by Bekele et al (USPN 6,607,737 hereafter '737). The claims are drawn to a cationic copolymer composition comprising a C20-C40 alcohol.

3. The '737 patent teaches a topical composition comprising cosmetic polymers in an oil-in-water emulsion (abstract, col. 14, lin. 56-65). The polymers include cationic copolymers such as

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polyquaternium-7 (col. 9, lin. 15-20). Polyquaternium-7 is a cationic copolymer that is a copolymer of dimethyl ammonium chloride with acrylamide with molecular weights from 100,000-1.5 million, and 70-80% weight of acrylamide and 20-30% by weight of dialkyl dimethyl ammonium chloride cationic monomer units. The cationic polymer is present in a concentration 0.01-20% wt (col. 9, lin. 55-60). The formulation comprises lanolin oil (example 12). The formulation further comprises optional polymers including such as synthetics like polyvinylpyrrolidone and cellulose derivatives such as hydroxypropylcellulose (col. 17, lin. 52-58) or further higher molecular weight polyquaternium polymers (col. 9, lin. 20-25). The cosmetic formulation can be applied as mascaras, lipsticks or eyeliners (claims). The formulation comprises waxes, fats, pigments, and water-soluble film forming polymers (examples). The formulations are applied as improved cosmetics with long wear properties (col. 1, lin. 12-17). These disclosures render the claims anticipated.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1,10,12,14, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the disclosures of Bekele et al (USPN 6,607,737 hereafter '737). The claims are drawn to a cosmetic formulation comprising high molecular weight cationic polymers, oils, waxes, fats water soluble polymers and at least one pigment.
7. As discussed above the '737 patent discloses an oil-in-water emulsion mascara comprising cationic polymers in concentration from 0.1-20%, lanolin alcohol, ~6% of a wax, ~8% of an oil and ~4.5% of a pigment. The formulation discloses different concentrations of the alcohol, yet it is the position of the Examiner that such a limitations does not impart patentability on the claim. The formulation of the prior art does the same thing, with the same components. It is incumbent upon Applicant to provide any evidence of an unexpected result regarding the specific concentration of the lanolin alcohol in the formulation. It is the position of the Examiner that the general conditions of the claims have been met. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *See In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).
8. Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various cosmetic compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not

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patentable absent a showing of criticality. *See In re Russell*, 439 F.2d 1228 169 USPQ 426 (CCPA 1971).

9. With these things in mind it would have been obvious to follow the teachings and suggestions of the art to optimize the concentrations of the alcohol in order to improve the stability and consistency of the resulting cosmetic. One of ordinary skill in the art would have been motivated to follow these teachings with an expected result of a stable cosmetic with long lasting properties.

#### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Luke (USPN 6,277,385 hereafter '385) discloses a cosmetic formulation comprising cationic polymers with molecular weights from 100,000-1 million.

#### ***Correspondence***

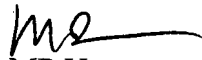
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Micah-Paul Young whose telephone number is 571-272-0608. The examiner can normally be reached on M-F 6:00-3:30 every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Micah-Paul Young  
Examiner  
Art Unit 1618

  
MP Young

  
MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER